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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,498	02/19/2002	Ernst-Walter Hillebrand	HILL 102	7649
26568	7590	03/03/2004	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			OLTMANS, ANDREW L	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/049,498

Applicant(s)

HILLEBRAND, ERNST-WALTER

Examiner

Andrew L Oltmans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 5 is objected to because of the following informalities:

In the amendment filed November 25, 2003, the number indicating the claim number of claim number 5 is missing. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Notes regarding claim interpretation:

Claims 3 and 4 have been amended to include the limitation “to the passivated zinc-nickel coat”. The antecedent basis of the term “passivated...coat” is the passivated (i.e. oxidized) surface produced in claim 1.

The term “zinc/nickel”, throughout the claims, have been amended to read “zinc-nickel”, wherein the term “zinc-nickel” has been interpreted to mean an alloy that contains zinc *and* nickel.

***EP 0 760 401 A1 Inoue et al.***

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 760 401 A1 Inoue et al. (EP ‘401; cited on IDS filed March 26, 2002).

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EP '401 teaches method of passivating galvanic zinc/nickel coating wherein the coating is contacting with a composition that includes an oxidizing agent, wherein the oxidizing agent includes peroxide sulfate (i.e. ammonium persulfate) (page 2, lines 39-43 and page 3, lines 46-48). EP '401 teaches that Zn alloy plating films are most preferred (page 3, lines 47-48). EP '401 teaches that the pH of the coating composition is "preferably 1.5 to 3.0" (page 3, line 16). EP '401 further teaches that the passivated surface may be coated (i.e. with a conversion coat) with an organic or inorganic composition wherein the organic composition encompasses polymer wax (page 3, lines 51-55). The claims do not distinguish over the teachings of EP '401.

With respect to the pH of the oxidizing solution, the recitation of a pH "preferably 1.5 to 3.0" is sufficient to teach the range with sufficient specificity to anticipate the claim, see MPEP 2131.03.

***JP 01255675 A Nisshin Steel***

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated JP 01255675 A Nisshin Steel (JP '675; cited on IDS filed March 26, 2002).

JP '675 teaches a method of passivating galvanic zinc-nickel coating wherein the coating is contacting with a composition that includes an oxidizing agent (see the English language abstract of each of the reference). JP '675 teaches that the pH of the coating composition is less than or equal to 3 (see the English language abstracts of each of the references). The claims do not distinguish over the teachings of JP '675.

With respect to the pH of the oxidizing solution, the recitation of a pH less than or equal to 3 is sufficient to teach the range with sufficient specificity to anticipate the claim, see MPEP 2131.03.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***SU 1801987 A1Nagirnyi et al., JP 61238979 A Kobe Steel and JP 60121275 A Sumitomo Metal***

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over each of SU 1801987 A1Nagirnyi et al. (SU '987; cited on IDS filed March 26, 2002), JP 61238979 A Kobe Steel (JP '979; cited on IDS filed March 26, 2002) and JP 60121275 A Sumitomo Metal (JP '275; cited on IDS filed March 26, 2002).

SU '987, JP '979 and JP '275 teach a method of passivating galvanic zinc-nickel coating wherein the coating is contacting with a composition that includes an oxidizing agent (see the English language abstracts of each of the references). SU '987, JP '979 and JP '275 teach that the coating composition is acidic (see the English language abstracts of each of the references).

SU '987, JP '979 and JP '275 fail to meet all the limitations of the instant claims in that SU '987, JP '979 and JP '275 do not explicitly teach the exact pH instantly claimed.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the composition taught by the reference has a pH (i.e. a pH in the acidic range) which overlaps that of the instant claims. It would have

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been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range (i.e. pH of 1.8), from the broader range disclosed in SU '987, JP '979 and JP '275 because SU '987, JP '979 and JP '275 find that the prior art composition in the entire disclosed range has a suitable utility used for the same purpose (i.e. oxidizing/passivating Zn-Ni alloys with an oxidizing agent). See In re Peterson, 65 USPQ2d 1379, In re Malagari, 182 USPQ 549, and MPEP 2144.05.

***JP 60121275 A Sumitomo Metal (applied to claims 3-5)***

7. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60121275 A Sumitomo Metal (JP '275; cited on IDS filed March 26, 2002).

JP '275 teaches and is applied as above in paragraph 6. JP '275 further teaches that the passivated Zn-Ni alloy is conversion coated with a phosphate or chromate, wherein the film including an organic high polymer composition (i.e. polymer wax) (see English Language translation of abstract).

***JP 60121275 A Sumitomo Metal and EP 0 760 401 A1 Inoue et al.***

NOTE: References to JP '449 are to the English language abstract or the English language translation provided by the examiner.

8. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60121275 A Sumitomo Metal (JP '275; cited on IDS filed March 26, 2002) and EP 0 760 401 A1 Inoue et al. (EP '401; cited on IDS filed March 26, 2002) in view of JP 05237449 A Kawasaki Steel (JP '449).

JP '275 and EP '401 teach and are applied as set forth in paragraphs 3 and 6-7, above.

JP '275 and EP '401 fail to meet all the limitations of the instant claims in that JP '275 and EP '401 do not explicitly teach the application of a dry lubricant.

JP '449 teaches that galvanic coating that are passivated are conventionally coated with a dry lubricant coating containing a polyolefin wax (i.e. a wax such as that claimed in claim 4), wherein the lubricating resin improves, among other things, multistage moldability at high speed (abstract, paragraphs [0001] to [0005] and paragraph [0012]).

One of ordinary skill in the art at the time that the invention was made would have found the invention to be obvious because one of ordinary skill in the art would have been motivated to add the lubricant coating of JP '449 to the passivated galvanic coatings of JP '275 or EP '401 in order to provide the desirable properties of lubricity of multistage moldability at high speed, as taught in JP '449 (see abstract).

### ***Response to Arguments***

9. Applicant's arguments filed November 25, 2003 have been fully considered but they are not persuasive. Claims 1-5 remain pending in this application. Claim 5 has been objected to for missing the claim number. The rejections have been maintained and amended in response to applicant's amendment.

10. The examiner notes that the claim is a method wherein the method includes a single step, wherein the single step is merely oxidizing with an oxidizing agent (claim 1, line 3), agent, wherein the oxidizing agent is not limited in claim 1, wherein the oxidizing takes place at a claimed pH (i.e. 1.8). The prior art applied all teach the substrate (i.e. the Zn-Ni alloy) and an oxidizing step including an oxidizing.

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11. With respect to applicant's arguments throughout the remarks involving the use of Cr(VI) (i.e. carcinogenic materials), constant process control, removal of the material due to oxidation (vs. deposition), limit on waste water (i.e. disposal), adhesion properties, inclusion of separate coatings, time of coating (i.e. quick), simplicity of the procedure, expense, quality of the film, and excellent coating characteristics, the argument is not found persuasive because none of the argued properties or advantages are present in the instant claims. For example, the claim, as current drafted does not preclude the inclusion of carcinogenic materials, such as Cr (VI), or preclude the inclusion of additional coating steps. Although applicant has alleged advantages of the claimed process, no data or evidence has been provided to support the allegations of new and unexpected results. Further, secondary considerations, such as new and unexpected results, are only applicable to non-obviousness and are not applicable to anticipated claims. Therefore, the arguments are not found persuasive.

12. With respect to applicant's arguments regarding JP '401, the arguments are not persuasive for the reasons set forth in the rejection above in paragraph 3. Specifically, the argument that JP '401 does not teach the Zn-Ni alloy is not persuasive because the reference includes examples drawn to Zn-Ni alloys and recites that Zn alloy (e.g. Zn-Ni) are preferred (page 3, lines 47-48). Likewise, JP '401 teaches a pH range that anticipates the claimed pH of 1.8, see MPEP 2131.03. Therefore, the arguments are not found persuasive.

13. With respect to the arguments that the specific references fail to recite the exact pH instantly claimed citing specific examples taught, the reference is not limited to the preferred embodiments, but rather is read as a whole, MPEP 2123:

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re



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Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

If the reference is read as a whole, the pH is taught, including preferred ranges, therefore making the instant invention anticipated or obvious.

14. For at least all of the above reasons, all of the arguments presented by applicant have not been found persuasive.

### *Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Oltmans whose telephone number is 571-272-1248. The examiner can normally be reached from 7:00 to 3:30, Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Andrew L. Oltmans  
Patent Examiner  
Art Unit 1742

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